

ATTORNEY DOCKET NO. 22022.0007US
APPLICATION NO. 09/427,811

REMARKS

This is a full and timely response to the non-final Office Action mailed by the U.S. Patent and Trademark Office on September 16, 2004. Claims 1-2 and 4-15 remain pending in the present application. In view of the amended claims and the following remarks, reconsideration and allowance of the application and claims are respectfully requested.

The undersigned patent attorney sincerely appreciates the time spent by Examiner Mirza during a telephonic interview conducted on February 14, 2005. The interview proved to be very helpful in resolving issues with respect to the present claims.

During the interview, the undersigned and Examiner Mirza discussed the pending claims in light of the prior art. It was agreed that, pending approval from the client, the undersigned would amend the "determining a set of end users" step of the independent claims to add the general type of limitation present in dependent claim 3 (now canceled). Independent claims 1, 10, and 13 now incorporate the suggestions made by the Examiner, although the wording has been revised somewhat from claim 3 to better flow with the logic of the independent claims.

It was discussed during the interview that *Steinberger et al.* (U.S. Patent No. 6,219,705) would no longer be asserted as a secondary reference, given that it is not prior art due to the earlier priority date of the present application. It was also discussed that *Inala et al.* (U.S. Patent No. 6,199,077) would not be asserted due to the priority date of the present application and because *Inala* is assigned to Yodlee, Inc., the beneficial owner of the present application.

Applicants respectfully submit that claims 1-2 and 4-15 are allowable for at least the reason that the Examiner has not established a prima facie case of obviousness under 35 U.S.C. 103(a). Specifically, Applicants assert that claims 1-2 and 4-15 are allowable over the cited references for at least the reason that the cited references do not disclose, teach, or suggest every limitation of the present application, a motivation to combine the asserted references, or provide a reasonable expectation of success at combining the asserted references to arrive at a system or method for scheduling the harvesting of personal information as claimed in the present application. Applicants also assert that independent claims 1, 10, and 13 are allowable for at least the reason that they incorporate the "condition" limitation inspired by claim 3 (now canceled) to more clearly distinguish over *Takagi* as suggested by the Examiner. Further, the

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dependent claims are allowable for at least the same reasons. Applicants also respectfully assert that claims 1-2 and 4-15 are allowable for at least the reasons asserted by Applicants in the Office Action responses dated September 6, 2002 and June 18, 2003, where applicable.

Rejections Under 35 U.S.C. § 103

Claims 1 and 4-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Takagi et al.* (hereinafter *Takagi*), U.S. Patent No. 6,243,755 in view of *Steinberger et al.* (hereinafter *Steinberger*), U.S. Patent No. 6,219,705. Claims 2 and 3 are also rejected under 103(a) over *Takagi* in view of *Steinberger* and further in view of *Inala et al.* (hereinafter *Inala*) (U.S. Patent No. 6,199,077). Each claim rejected under 103(a) will be presented in turn.

For a claim to be properly rejected under 35 U.S.C. 103, "[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted). In order to maintain a prima facie case of obviousness under 35 U.S.C. 103(a), three criteria must be met. Specifically, the Patent Examiner must show: (1) some suggestion or motivation in the prior art to combine reference teachings; (2) a reasonable expectation of success; and (3) the combination of references must teach or suggest all claim limitations. See, e.g., *In re Dow Chemical Company*, 837 F.2d 469 (Fed. Cir. 1988), and *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). To reject claims as obvious under 35 U.S.C. 103(a), the burden rests *on the Examiner* to establish *all elements* of the prima facie case. Unless the Examiner satisfies his burden of proving the prima facie case, claims may *not* be properly rejected as obvious.

Independent Claims 1, 10, and 13

The Examiner rejects independent claims 1, 10, and 13 of the present application on several grounds as being obvious over *Takagi* in view of *Steinberger*. Therefore, each ground of rejection applied to claims 1, 10, and 13 is discussed in turn.

With regard to claim 1, the Office Action states that *Takagi* discloses: "(a) determining an update time for information stored by a selected information provider (col. 4, lines 52-63);" Applicants respectfully point out that the cited lines of *Takagi* disclose only:

a computer usable medium having computer readable program
code means embodied therein for causing a computer to function
as a system for controlling an information transfer to a first

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information processing apparatus from a second information processing apparatus via a network, the computer readable program means including: first computer readable program code means for causing the computer to provide a first knowledge concerning an activity schedule of a user using the first information processing apparatus and a second knowledge concerning a relationship between a user's activity and an attribute of information;

It is respectfully submitted that the above-quoted lines of *Takagi* do not in fact disclose “(a) determining an update time for information stored by a selected information provider.” Rather, the quoted lines of *Takagi* relate to a *user's activity schedule*. The specification of *Takagi* provides examples of activity schedules and explains that an *activity schedule* is something the *user creates* to describe what the user will be doing and at what time and place he will be doing it. See, e.g., Fig. 5.

Determining what a *user* will be doing in accordance with an *activity schedule* bears no relation to the step recited in claim 1 of determining the time at which information stored by an *information provider* is to be *updated*. In Applicants' invention, various *information providers* store information that is known to be updated from time to time. Step (a) of the claimed method relates to determining when such *updates* are to occur. In contrast, the *activity schedule* of *Takagi* relates to the *user's* activity, not to any activity of an *information provider*. Thus, Applicants respectfully assert that *Takagi* does not disclose step (a) as in claim 1 of the present application.

With further regard to claim 1 as it existed prior to the present amendment, the Office Action states that *Takagi* discloses: “(b) determining a set of end users whose information could be modified by an update at the determined update time by the selected information provider (col. 5, lines 9-20).” Applicants respectfully point out that the cited lines of *Takagi* disclose only:

a computer usable medium having computer readable program code means embodied therein for causing a computer to function as a system for controlling an information transfer to a first information processing apparatus from a second information processing apparatus via a network, the computer readable

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program means including: first computer readable program code means for causing the computer to provide a knowledge concerning an *activity schedule of a user* using the first information processing apparatus; second computer readable program code means for causing the computer to *predict a necessary information* which will be required by a user using the first information processing apparatus in future and a necessary time by which the necessary information will be actually required by the user, according to the knowledge concerning an *activity schedule* of the user; . . . (Emphasis added).

It is respectfully submitted that the above-quoted lines of *Takagi* do not in fact disclose “(b) determining a set of end users whose information could be modified by an update at the determined update time by the selected information provider.” The quoted lines of *Takagi* relate to *predicting information* that will be required by a user in the future in accordance with the *activity schedule* discussed above, rather than determining a *set of end users* whose information *could be modified* by an update. Thus, Applicants respectfully assert that *Takagi* does not disclose step (b) as it existed prior to the present amendment of claim 1 of the present application.

Applicants also assert that *Takagi* does not disclose step (b) of claim 1 as amended to include the *condition* limitation of claim 3, now canceled.

Claim 3 stated:

. . . wherein the step of determining a set of end users further comprises eliminating end users not meeting a *condition* of the selected information provider *for information update* at the determined time. (Emphasis added).

Claim 1 now states in relevant part:

(b) determining a set of end users whose information satisfies a *condition for information update* at the determined update time; (Emphasis added).

Pursuant to the Examiner’s suggested amendment, the *condition* limitation from canceled dependent claim 3 has now been effectively incorporated into step (b) as currently amended. Applicants respectfully assert that step (b) of claim 1 is not disclosed by *Takagi* for at least the

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reason that *Takagi* does not teach or disclose determining a set of end users whose information satisfies a *condition for information update*.

With further regard to claim 1, the Office Action states that *Takagi* discloses:

“(c) generating a predicted login time for each end-user in the determined set of end users (col. 3, lines 40-46);” Applicants respectfully point out that the cited lines of *Takagi* disclose only:

prediction means for *predicting* a necessary *information* which will be required by a user in future and a necessary time by which the necessary information will be actually required by the user, according to a first knowledge concerning an *activity schedule* of the user and a second knowledge concerning a relationship between a user's activity and an attribute of information; . . .
(Emphasis added).

It is respectfully submitted that the above-quoted lines of *Takagi*, cited by the Examiner, do not in fact disclose: “(c) generating a *predicted login time* for each *end user* in the determined set of end users;” (Emphasis added). What is predicted in the *information caching* invention in *Takagi* is the *information* that will be required by a user in the future and the time at which the information will be required by the user. By way of comparison, *Takagi* discloses predicting *information* needed by an end user but not the *login time* of an end user. Therefore, Applicants respectfully assert that *Takagi* does not disclose step (c) as in claim 1 of the present application.

With further regard to claim 1, the Office Action states that *Takagi* discloses:

“(d) sorting determined set of end users according to the predicted login time generated for each end user in the determined set (col. 3, lines 57-67);” Applicants respectfully point out that the cited lines of *Takagi* disclose only:

prediction means for predicting a necessary information which will be required by a user using the first information processing apparatus in future and a necessary time by which the necessary information will be actually required by the user, according to a knowledge concerning an activity schedule of the user; and transfer control means for controlling the transfer of the necessary information from the second information processing apparatus to the first information processing apparatus via the network such that

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the necessary information will be transferred by the necessary time.

It is respectfully submitted that the above-quoted lines of *Takagi* do not in fact disclose “(d) *sorting* the determined *set of end users* according to the *predicted login time* generated for each end user in the determined set;” (Emphasis added). The above quoted language discloses a caching system which predicts when *information* will be required rather than predicted *login times* as in the present application.

Applicants assert that nothing in the above-quoted section of *Takagi* relates to *sorting*. The cited language only refers to *one user*, not a *set* of end users as required by step (d). There can be no *sorting* of end users unless there is *more than one* user to sort. Thus, it is asserted that *Takagi* does not disclose step (d) as in claim 1 of the present application.

Applicants respectfully assert that *Steinberger* is not a proper prior art reference against the present application, given that *Steinberger*'s filing date post dates the priority date of the present application, as discussed in the telephone interview with Examiner Mirza conducted on February 14, 2005.

In light of the above remarks, Applicants respectfully submit that independent claim 1 is allowable for at least the reason that the primary reference, *Takagi*, does not teach or disclose steps (a)-(d) of claim 1 of the present invention, and because *Steinberger* is not a proper prior art reference against the present application. Applicants therefore respectfully assert that the Examiner has not shown a prima face case of obviousness for claim 1 of the present application.

The limitations found in steps (a)-(e) of claim 1 are also recited in independent claims 10 and 13 of the present application. Applicants respectfully submit that the Examiner has not shown a prima face case of obviousness for independent claims 10 and 13 for at least the reasons asserted for claim 1. Thus, Applicants respectfully request allowance of independent claims 1, 10, and 13 of the present application.

Dependent Claims 4-9, 11-12, and 14-15

Applicants respectfully assert that dependent claims 4-9, 11-12, and 14-15, rejected by the Examiner as obvious under *Takagi* in view of *Steinberger*, are allowable for at least the reason that they depend from allowable independent claims 1, 10, or 13.

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Dependent Claims 2 and 3

The Examiner rejects claims 2 and 3 under 103(a) over *Takagi* in view of *Steinberger* and further in view of *Inala*. Claim 3 has now been canceled. Applicants respectfully assert that claim 2 is allowable for at least the reason that it depends from allowable claim 1, and because *Steinberger* and *Inala* are not proper prior art references as discussed previously.

In view of the foregoing remarks and amendments in light of the telephonic interview with the Examiner on February 14, 2005, the Applicants respectfully request allowance of claims 1-2 and 4-15 of the present application. If the Examiner believes discussion of any issue would expedite examination, the Examiner is encouraged to telephone Applicants' undersigned representative.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$450.00 representing the fee for a two-month extension-of-time for a large entity under 37 C.F.R. § 1.136(a) is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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